UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,351	09/05/2003	Takeshi Fukuizumi	Q77204	7037

23373 7590 03/15/2007	EXAMINER	
SUGHRUE MION, PLLC	PARK, JEONG S	
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SUITE 800	ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037	2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/655,351	FUKUIZUMI ET AL.
	Examiner	Art Unit
	Jeong S. Park	2109

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>9/5/2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-40</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-40</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>05 September 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>See Continuation Sheet</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9/5/2003, 2/26/2004, 5/16/2006, 2/22/2007.

DETAILED ACTION

1.   Foreign priority is not accepted because:

The inventors of the applicant claimed as a foreign priority patent document

(Japan P2002-262076) do not match with the current application inventors.

Specification

2.   The specification is objected to because:

The title of the invention is not descriptive.

A new title is required that is clearly indicative of the invention to which the claims

are directed.

3.   The specification is objected to because of the following informalities:

In pages 4, 5, 15, 16, 19, and 20, the word "chart" should be corrected as --chat--

Appropriate correction is required.

Claim Objections

4.   Claims 2-4, 6, 7, 10, 12-18, 22, 23, 30, and 35-40 are objected to because of the

following informalities:

In claim 2, line 3, the phrase "a chat end event" should be corrected as --said

chat end event-- for clear understanding of the claim;

In claim 2, line 4, the phrase "a prescribed timing" should be corrected as --said

prescribed timing-- for clear understanding of the claim;

In claim 3, lines 9 and 11, the phrase "a prescribed timing" should be corrected

as --said prescribed timing-- for clear understanding of the claim;

In claim 4, line 5, the phrase "users available" should be corrected as --said

users available-- for clear understanding of the claim;

In claim 6, line 5, the phrase "a predetermined span of time" should be corrected

as --said predetermined span of time-- for clear understanding of the claim;

In claim 7, line 5, the phrase "a predetermined span of time" should be corrected

as --said predetermined span of time-- for clear understanding of the claim;

In claim 10, line 3, the phrase "a group organizing unit" should be corrected as --

said group organizing unit-- for clear understanding of the claim;

In claim 12, line 7, the phrase "a group organizing unit" should be corrected as --

said group organizing unit-- for clear understanding of the claim;

In claim 13, line 7, the phrase "a group organizing unit" should be corrected as --

said group organizing unit-- for clear understanding of the claim;

In claim 13, line 9, the phrase "a specific user" should be corrected as --

said specific user-- for clear understanding of the claim;

In claim 14, line 3, the phrase "a group organizing unit" should be corrected as --

said group organizing unit-- for clear understanding of the claim;

In claim 15, line 3, the phrase "an end event detecting unit" should be corrected

as --said end event detecting unit-- for clear understanding of the claim;

In claim 16, line 3, the phrase "an end event detecting unit" should be corrected

as --said end event detecting unit-- for clear understanding of the claim;

In claim 17, lines 12 and 15, the word "chart" should be corrected as --chat--;

In claim 18, line 9, the word "chart" should be corrected as --chat--;

In claim 22, line 4, the phrase "a predetermined span of time" should be corrected as –said predetermined span of time-- for clear understanding of the claim;

In claim 23, line 3, the phrase "a predetermined span of time" should be corrected as –said predetermined span of time-- for clear understanding of the claim;

In claim 30, line 4, the phrase "presence information" should be corrected as –said presence information-- for clear understanding of the claim;

In claim 35, line 5, the phrase "a plurality of user terminals" should be corrected as –said plurality of user terminals-- for clear understanding of the claim;

In claim 36, line 6, the phrase "a prescribed timing" should be corrected as --said prescribed timing-- for clear understanding of the claim;

In claim 37, line 3, the phrase "a prescribed timing" should be corrected as --said prescribed timing-- for clear understanding of the claim;

In claim 38, line 6, the phrase "a plurality of user terminals" should be corrected as –said plurality of user terminals-- for clear understanding of the claim;

In claim 39, line 5, the phrase "a prescribed timing" should be corrected as --said prescribed timing-- for clear understanding of the claim; and

In claim 40, line 2, the phrase "a prescribed timing" should be corrected as --said prescribed timing-- for clear understanding of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   Claims 3, 4, 9-11, 14-16, 19, 27, 28, 31-33, and 35-40 are rejected under 35

U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 3 is drawn towards a buddy list generating/updating unit for generating a

buddy list information and transmitting it. This can be just an abstract idea or a

computer program as the applicant mentioned in the specification. The computer

program is not in one of the statutory categories. In order for an abstract claim to be

statutory, it must result in useful, concrete, and tangible results. The final result

achieved by the claimed invention does not produce any tangible result.

Claim 4 is drawn towards a filtering unit for referencing a buddy list information

and selecting users available for chatting. This can be just an abstract idea or a

computer program as the applicant mentioned in the specification. The computer

program is not in one of the statutory categories. In order for an abstract claim to be

statutory, it must result in useful, concrete, and tangible results. The final result

achieved by the claimed invention does not produce any tangible result.

Claims 9, 10, 14, 27, 28, and 31 are drawn towards a group organizing unit for

receiving email and perceiving the occurrence of a chat start event. This can be just an

abstract idea or a computer program as the applicant mentioned in the specification.

The computer program is not in one of the statutory categories. In order for an abstract

claim to be statutory, it must result in useful, concrete, and tangible results. The final

result achieved by the claimed invention does not produce any tangible result.

Claims 11, 15, 16, 19, 32, and 33 are drawn towards an end event detecting unit for detecting an end time and perceiving the chat end event. This can be just an abstract idea or a computer program as the applicant mentioned in the specification. The computer program is not in one of the statutory categories. In order for an abstract claim to be statutory, it must result in useful, concrete, and tangible results. The final result achieved by the claimed invention does not produce any tangible result.

Independent claim 35 is drawn towards a method of using communication server comprising the steps of starting a chat and sending said chat. This can be just an abstract idea. In order for an abstract claim to be statutory, it must result in useful, concrete, and tangible results. The final result achieved by the claimed invention does not produce any tangible result.

Claims 36-37, which are dependent on claim 35, do not add any tangible results to the claim and thus are rejected for the same.

Independent claim 38 is drawn towards a computer program for causing communication comprising the steps of starting a chat and sending said chat. The computer program is not in one of the statutory categories. The specification provides no explicit and deliberate definition of the computer program. Also this can be just an abstract idea. In order for an abstract claim to be statutory, it must result in useful, concrete, and tangible results. The final result achieved by the claimed invention does not produce any tangible result.

Claims 39-40, which are dependent on claim 38, do not add any tangible results to the claim and thus are rejected for the same.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.   Claims 1, 8, 12, 14, 17, 18, 24, and 31 are rejected under 35 U.S.C. 102(e) as

being anticipated by Baker (U.S. Pub. No. US 2001/0048449 A1).

Regarding claim 1, Baker discloses as follows:

A communication system (chat room system, reference character 20 in figure 1),

comprising; ·

A plurality of user terminals connected to a communication network (chatter

system enables a plurality of users, or chatters located at computer workstations,

access the system via the Internet, WAN, or LAN, see, e.g., page 5, paragraph [0051]

and figure 1); and

A communication server (chat host system, reference character 30 in figure 1)

connected to said communication network (see, e.g., page 5, paragraph [0051], lines 1-

9) wherein: said communication server, when a chat start event has occurred, causes a

chat to be started at a prescribed timing among those user terminals out of said plurality

of user terminals, related in advance to said chat start event (chat room system email

with the time that multiple compatible chatters agree to meet in the system, see, e.g.,

page 8, paragraph [0088] and figure 6).

Regarding claim 8, Baker discloses that said communication server

registers users present in predetermined positions as the users of user terminals

related to said chat start event (a positioning information is used to evaluate

compatibility, which means when the communication server forms a chat room it

considers the present location of each chatter, see, e.g., page 8, paragraph [0090] and

[0092]).

Regarding claims 12, 14, and 31 Baker discloses as follows:

A presence information database (reference character 32 in figure 4) in which is

registered presence information indicating whether or not the users of said user

terminals are accessible or inaccessible (the personal information is defined in the

chatter list on disk, contains on-line time among the others, see, e.g., page 7, paragraph

[0074], [0075] and figure 4); and

A group organizing unit (chatter list, reference character 150 in figure 4)

reference said presence information database and perceives the occurrence of said

chat start event (see, e.g., page 7, paragraph [0074] and figure 4) when a

predetermined first point of time has come (see, e.g., page 8, paragraph [0088]).

Regarding claims 17 and 18, Baker discloses as follows:

A present information database are registered an identifier by which each of said

plurality of user terminals identifies itself and related information (at least one database

containing information pertaining to the profiles of chatters, see, e.g., page 5, paragraph

[0051]);

A group organizing unit (chatter list, reference character 150 in figure 4)

references said presence information database and selects identifier (see, e.g., page 7,

paragraph [0074] and figure 4); and

A buddy list generating/updating unit, which generates a buddy list information

database, transmits chat start information to user terminals matched to identifiers

relating to said start event out of said plurality of user terminals, wherein said chat start

information is an item of information to cause a chat to start at a prescribed timing

among said plurality of user terminals (IDPP system automatically notifies or pages the

compatible chatters to be introduced, see, e.g., page 5, paragraph [0054]).

Regarding claim 24, Baker discloses all the limitations of claim as explained

above regarding claims 8 and 17.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 2-7, 9-11, 13, 15, 16, 19-23, 25-30, 32, 33, and 35-40 are rejected under

35 U.S.C. 103(a) as being unpatentable over Baker (U.S. Pub. No. US 2001/0048449

A1) in view of Trovato et al. (hereinafter Trovato)(U.S. Pub. No. US 2002/0174234 A1).

Regarding claim 2, Baker discloses all the limitations of claims 1 and 2 as explained above except for disclosure of the communication server causes the chat to end at a prescribed timing.

The general concept of controlling chat ending at a prescribed timing by the communication server is well known within the art as illustrated by Trovato which discloses as follows:

A chat server (reference character 100 in figure 1) includes an access request processor and a network former (reference character 130 in figure 1)(see, e.g., page 1, paragraph [0015]); and

The network former terminates each chat network after a given period of time (see, e.g., page 3, paragraph [0023], lines 1-11).

·It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Baker to include the server controlled chat termination at prescribed timing as taught by Trovato in order to terminate the existing inactive chat rooms for supporting the capacity for the future active chat rooms.

Regarding claim 3, Baker discloses as follows:

Said communication server is further provided with a buddy list generating/updating unit (intelligence driven paging process, hereinafter IDPP, is a proactive and automated process for identifying compatible chatters, see, e.g., page 5 paragraph [0053]);

The buddy list generating/updating unit generates a buddy list information which relates the users of said plurality of user terminals to one another as buddies (IDPP

system determines the compatibility score among the plurality of chatters, see, e.g.,

page 5, paragraph [0054]); and

The buddy list generating/updating unit transmits the buddy list information to

said plurality of user terminals at a prescribed timing (IDPP system automatically

notifies or pages the compatible chatters to be introduced, see, e.g., page 5, paragraph

[0054]).

Baker does not disclose of transmitting a delete information to user terminals at a

prescribed timing.

The general concept of transmitting the delete information to user terminals is

well known within the art as illustrated by Trovato which discloses that the network

former (reference character 130 in figure 1) terminates each chat network after a given

period of time (see, e.g., page 3, paragraph [0023], lines 1-11).

It would have been obvious for one of ordinary skill in the art at the time of the

invention to modify Baker to include the network former to terminate each chat network

at a prescribed timing as taught by Trovato in order to terminate the existing inactive

chat rooms for supporting the capacity for the future active chat rooms.

Regarding claim 4, Baker discloses that each user terminal is provided with a

filtering unit for referencing available users from the buddy list information and selecting

the available users (the chat window shows the other chatters in a room received from

IDPP, see, e.g., page 5, paragraph [0054] and reference character 110 in figure 2).

Regarding claims 5-7 and 21-23, Baker discloses all the limitations of claims as

explained above except for registering users each having a call, transmitting an email,

or purchasing tickets within a predetermined span of time by using their respective user terminals.

Trovato discloses that parameters and events used to form chat networks based on the time of each user access request, which means the communication system is closely monitoring or registering user terminal's activities during the predetermined span of access times (see, e.g., page 2, paragraph [0017], [0020], and table 1);

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Baker to include monitoring or registering user terminal's activities within a predetermined span of time as taught by Trovato in order to form a proper chat room based on each chatter's real time activities through their user terminals.

Regarding claims 9, 10, 27, and 28, Baker discloses all the limitations of claims 9-10 as explained above except for providing a group organizing unit for receiving an email.

Trovato discloses that parameters and events used to form chat networks based on the time of each user access request, which means the communication system is closely monitoring or registering user terminal's email activities to perceive an occurrence of the chat start event (see, e.g., page 2, paragraph [0017], [0020], and table 1);

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Baker to include monitoring user terminal's email activities as taught by Trovato in order to form a proper chat room based on each chatter's real time email activities through their user terminals.

Regarding claims 11, 15, and 32, Trovato discloses that an end event detecting unit (network former, reference character 130 in figure 1) detects the ending time after the lapse of a set length of time from the point of time when said chat start event occurred or when a predetermined second point of time has come and perceive said chat end event (chat network is scheduled to be close one hour after the end of the television program, see, e.g., page 3, paragraph [0023], lines 8-11).

It would have been obvious to combine the teachings of Trovato with Baker for reasons previously discussed in claims 2 and 3.

Regarding claim 16, Trovato discloses that an end event detecting unit (network former, reference character 130 in figure 1) perceives the occurrence of said chat end event if no transmission/reception of messages takes place (chat network will be terminated after a given period of time of no activity among the users, see, e.g., page 3, paragraph [0023], lines 1-5).

It would have been obvious to combine the teachings of Trovato with Baker for reasons previously discussed in claim 2.

Regarding claim 13, Baker discloses that a presence information database (reference character 32 in figure 4) in which is registered presence information indicating that the users of said user terminals are inaccessible (the personal information is defined in the chatter list on disk, contains on-line time among the others, see, e.g., page 7, paragraph [0074], [0075] and figure 4) except for the group organizing unit perceiving the chat end event.

Trovato discloses that a group organizing unit (network former, reference character 130 in figure 1) reference said presence information database and perceives the occurrence of said chat end event (see, e.g., page 3, paragraph [0023] and figure 1)

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Baker to include the function of perceiving a chat end event as taught by Trovato in order to terminate efficiently the current chat room based on each chatter's real time activities.

Regarding claims 19 and 20, Baker and Trovato disclose all the limitations of claims as explained above regarding claims 3 and 11.

Regarding claim 25, Baker and Trovato disclose all the limitations of claim as explained above regarding claims 3, 11, and 18.

Regarding claim 26, 29, Baker and Trovato disclose all the limitations of claims as explained above regarding claims 12 and 17.

Regarding claim 30, Baker and Trovato disclose all the limitations of claim as explained above regarding claims 11 and 12.

Regarding claim 33, Baker and Trovato disclose all the limitations of claim as explained above regarding claims 11 and 16.

Regarding claims 35 and 38, Baker discloses as follows:

A communication method using a communication server (chat host system, reference character 30 in figure 1) connected to a plurality of user terminals via a communication network (chatter system enables a plurality of users, or chatters located

at computer workstations, access the system via the Internet, WAN, or LAN, see, e.g.,

page 5, paragraph [0051] and figure 1), comprising the steps of; and

Starting a chat at a prescribed timing, when a chat start event has occurred,

among a plurality of user terminals, out of said user terminals, related in advance to said

chat start event (chat room system email with the time that multiple compatible chatters

agree to meet in the system, see, e.g., page 8, paragraph [0088] and figure 6).

Baker does not disclose of a method of ending the chat at a prescribed timing.

The general concept of a method of ending the chat at a prescribed is well known

within the art as illustrated by Trovato which discloses as follows:

A chat server (reference character 100 in figure 1) includes an access request

processor and a network former (reference character 130 in figure 1)(see, e.g., page 1,

paragraph [0015]); and

The network former terminates each chat network after a given period of time

(see, e.g., page 3, paragraph [0023], lines 1-11).

It would have been obvious for one of ordinary skill in the art at the time of the

invention to modify Baker to include the method of ending the chat at a prescribed

timing as taught by Trovato in order to terminate the existing inactive chat rooms for

supporting the capacity for the future active chat rooms.

Regarding claim 36, 37, 39, and 40, Baker and Trovato disclose all the limitations

of claims as explained above regarding claims 3, 12, and 35.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

12.   Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker

(U.S. Pub. No. US 2001/0048449 A1) in view of Miller et al. (hereinafter Miller)(U.S.

Patent No. 5,475,819).

Baker discloses all the limitations of claim as explained above regarding claims 1

and 17 except for the plurality of communication servers.

Miller discloses the plurality communication servers and each of the servers

provides one or more services to the network (see, e.g., col. 3, lines 21-27 and

reference character 15 in figure 1).

It would have been obvious for one of ordinary skill in the art at the time of the

invention to modify Baker to include the plurality of servers to provide one or more

services as taught by Miller in order to extent chat room service widely among multiple

chatters by connecting the plurality of networks together.

Conclusion

13.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jeong S. Park whose telephone number is 571-270-

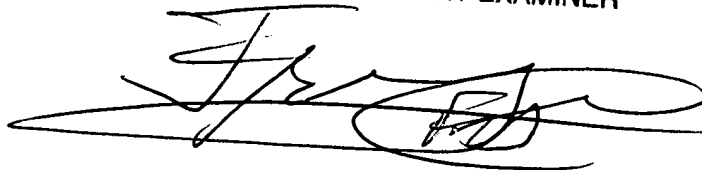1597. The examiner can normally be reached on Monday through Thursday 7:30 - 5:00

EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Frantz Jules can be reached on 571-272--6681. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSP
February 27, 2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER